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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,388	09/16/2003	Mitchell E. Lutz	20002.0333	2175
23517	7590	02/27/2006	EXAMINER	
SWIDLER BERLIN LLP 3000 K STREET, NW BOX IP WASHINGTON, DC 20007			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/662,388	Applicant(s) LUTZ ET AL.	
	Examiner David Buttner	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 32-37, 39-43, 45 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13, 32-37, 39-43, 45, 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The lined out foreign language references on the 1449 form were not provided with an English explanation. The Jeffamine article was not provided.

Claims 1-3,5-13,32-37,39-43,45 and 47-49 now read on the elected species.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 42 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood how the non-functional alkyl(meth)acrylates such as methylmethacrylate could react with a polyurethane backbone to result in pendant acrylic functionality.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39,40,45 and 49 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 39 and 49 allow for 0% acrylate which is broader than the independent claims requiring the presence of acrylate.

Claim 45's second structure is a polyurea – not a polyurethane.

Art Unit: 1712

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,5,6,8-10,39 and 49 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bradley '836.

Bradley exemplifies (table 1) golf ball covers of polydiene rubbers, polyurethane, zinc diacrylate and peroxide. The zinc diacrylate qualifies applicant's acrylate functional component. Applicant's "cast" limitation in claim 1 is product by process in nature. Any molding method (eg casting, compression molding etc) would result in the same final object.

Claims 1,2,5,6,8-10,39 and 49 rejected under 35 U.S.C. 103(a) as obvious over Bradley '836 in view of Marshall '873.

Bradley does not appear to suggest casting his cover.

Casting, compression molding and injection molding are the general methods of molding golf ball cores (col 1 line 48 of Marshall). It would have been obvious to use any common molding technique (including casting) for forming the cover of Bradley.

Claims 1,2,5-10,39 and 49 rejected under 35 U.S.C. 103(a) as obvious over Bradley '836 in view of Ladd '040.

Bradley does not suggest azo initiators.

Ladd lists azo compounds (col 6 line 67) and numerous species of peroxides (col 7 line 10-46) as alternative free radical initiators for rubbery golf ball compositions. It would have been obvious to use any of these known free radical initiators in Bradley's cover.

Claims 1,2,5,6,8,9 and 11-13 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nesbitt '704.

Nesbitt exemplifies (#4) golf ball covers of EPDM, filler, trimethylolpropanetrimethacrylate and peroxide. The trimethacrylate qualifies as applicant's acrylate functional component. Applicant's "cast" limitation in claim 1 is product by process in nature. Any molding method (eg casting, compression molding etc) would result in the same final object.

Claims 1,2,5,6,8,9 and 11-13 rejected under 35 U.S.C. 103(a) as obvious over Nesbitt '704 in view of Marshall 873.

Nesbitt does not appear to suggest casting his cover.

Casting, compression molding and injection molding are the general methods of molding golf ball cores (col 1 line 48 of Marshall). It would have been obvious to use any common molding technique (including casting) for forming the cover of Nesbitt.

Claims 1,2,5,6-9 and 11-13 rejected under 35 U.S.C. 103(a) as obvious over Nesbitt '704 in view of Ladd '040.

Nesbitt does not suggest azo initiators.

Ladd lists azo compounds (col 6 line 67) and numerous species of peroxides (col 7 line 10-46) as alternative free radical initiators for rubbery golf ball compositions. It would have been obvious to use any of these known free radical initiators in Nesbitt's cover.

Claims 1-3,5,6,8,9,32-36,39-41,43,45,47 and 49 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DiSalvo '849.

DiSalvo exemplifies (#5) a wound golf ball having a cover of polybutadiene, peroxide, zinc dimethacrylate, and a reaction product of hydroxyethylacrylate with a diisocyanate. This reaction product qualifies as a urethane acrylate. The urethane acrylate can also be based on a polyurethane when  $P_z$  is polyurethane (col 1 line 49). The windings can be considered an intermediate layer. The composition can be cast (col 1 line 66).

Claims 1-3,5,6,8,9,32-37,39-41,43,45 and 47-49 rejected under 35 U.S.C. 103(a) as obvious over DiSalvo '849 in view of Ladd '040.

DiSalvo does not suggest applicant's preferred peroxide initiators.

Ladd lists numerous species of peroxides (col 7 line10-46) as alternative free radical initiators for rubbery golf ball compositions. It would have been obvious to use any of these known peroxide initiators in DiSalvo's cover.

Applicant's arguments filed 12/12/05 have been fully considered but they are not persuasive.

The previous rejections are withdrawn due to the requirement of the material being in the cover.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner      DAVID J. BUTTNER  
                            PRIMARY EXAMINER

2/21/06

